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LILIAN					

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33M1/0226

EXAMINER	
TUCKER, G	
ART UNIT	PAPER NUMBER
3309	

DATE MAILED: 02/26/97

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

**Office Action Summary**Application No.  
**08/707,991**

Applicant(s)

**Bryan**

Examiner

**Guy Tucker**Group Art Unit  
**3309**☐ Responsive to communication(s) filed on \_\_\_\_\_☐ This action is **FINAL**.☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**☒ Claim(s) 1-30 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 1-12 is/are allowed.☒ Claim(s) 13-24 and 26-29 is/are rejected.☒ Claim(s) 25 and 30 is/are objected to.☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.**Application Papers**☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.☒ The specification is objected to by the Examiner.☒ The oath or declaration is objected to by the Examiner.**Priority under 35 U.S.C. § 119**☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).**Attachment(s)**☒ Notice of References Cited, PTO-892☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_☐ Interview Summary, PTO-413☒ Notice of Draftsperson's Patent Drawing Review, PTO-948☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration in a continuation-in-part application filed under the conditions specified in 35 U.S.C. 120 which discloses and claims subject matter in addition to that disclosed in the prior copending application, acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56 which occurred between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

The disclosure is objected to because of the following informalities:

there is no figure 3 (see page 11, line 25 and page 19, line 21), and

there is no brief description of figure 3B.

Appropriate correction is required.

35 U.S.C. 101 reads as follows:

“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title”.

Claims 13-22 are rejected under 35 U.S.C. 101 because a human being or a part of a human being is positively recited. The positive recitation occurs at claim 13, line 15.

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Then Assistant Secretary and Commissioner of Patents and Trademarks, Donald J. Quigg, issued a notice in the Official Gazette stating, "A claim directed to or including within its scope a human being will not be considered to be patentable subject matter under 35 U.S.C. 101. The grant of a limited, but exclusive property right in a human being is prohibited by the Constitution". 1077 OG 24(1987), reprinted in 1146 TMOG 24(1993).

Claim 15 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 15, line 5 is meaningless.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(A) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-16, 19 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Frigg (5,344,422) in view of Yuan et al (5,437,669). Frigg discloses the invention substantially as claimed. Frigg discloses a stem clamp (right side of "9" in figure 1) and a c-clamp (left side of "9"). However, Frigg does not disclose two spinal rods and a transverse connector. Yuan et al

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teaches two spinal rods and a transverse connector in the same field of endeavor for the purpose of allowing for a different type of spinal fixation. It would have been obvious to one having ordinary skill in the art at the time the invention was made, in view of Yuan et al, to provide a two rod and transverse connector type system with the device of Frigg in order to allow the device to be used in different types of procedures. Regarding claim 14, note the second transverse member in Yuan et al. Regarding claims 15 and 16, note the threads in element 22 of Frigg. Regarding claim 19, note that the clamp opens. Regarding claim 22, Frigg and Yuan et al do not show a pin. It is well known to provide pins for temporary attachment. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the system of Frigg as modified by Yuan et al with pins for temporary attachment.

The following non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. In re Sarett, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964); In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); In re White, 405 F.2d 904, 160 USPQ 644 (CCPA 1969); In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970) In re Van Ornam, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and In re Goodman, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) would overcome

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an actual or provisional rejection on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Claims 23, 24 and 26-29 are rejected under the judicially created doctrine of double patenting.

The subject matter recited in claims 23, 24 and 26-29 of the present patent application - "comprising ABCY" - is fully disclosed in the patent (or application if this is a provisional rejection). The allowance of claims 23, 24 and 26-29 would extend the rights to exclude already granted in 5,498,262 - that right to exclude covering the invention "comprising ABCX". The transitional phrase "comprising" does not exclude the presence of elements other than A, B, C, X in the claim. Because of the phrase "comprising" the patent not only provides protection to ABCX but also extends patent coverage to the disclosed combination - ABCXY. Likewise, if allowed, the claim(s) of the present application, because of the phrase "comprising", not only would provide patent protection to the claimed combination ABCY but would also extend patent coverage to the combination ABCXY - already disclosed and covered by '262. Thus, the controlling fact is that patent protection for the invention, fully disclosed in and covered by '262, would be extended by the allowance of claims 23, 24 and 26-29 in the present application.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims 23, 24 and 26-29 in the application during the prosecution of '262.

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Claims 17, 18, 20 and 21 would be allowable if rewritten to overcome the rejection under 35 U.S.C. 101 and to include all of the limitations of the base claim and any intervening claims.

Claims 25 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

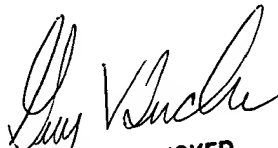
Claims 1-12 are allowable over the prior art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Guy Tucker at telephone number (703) 308-3271. Examiner Tucker can normally be reached on Monday through Thursday from 7:00 AM to 5:30 PM, Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, examiner Tucker's supervisor, Michael Buiz, can be reached at (703) 308-0871. The fax number for Group 3300 is (703) 305-3590 or 3591.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group 3300 receptionist at (703) 308-0858.

GVT  
February 14, 1997

  
GUY V. TUCKER  
PRIMARY EXAMINER  
GROUP 3300